

1/29/10 #22

PATENT  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl No. : 08/964,305 Confirmation No. 2101  
Applicant : Barry Katz  
Filed : November 4, 1997  
Title : ASYNCHRONOUS VIDEO EVENT AND TRANSACTION DATA  
MULTIPLEXING TECHNIQUE FOR SURVEILLANCE SYSTEMS  
Patent No. : 5,920,338  
Issued : July 6, 1999  
Examiner : Y. Young Lee  
Docket No. : A10:01462  
Customer No. : 71897

PETITION UNDER 37 C.F.R. § 1.182 FOR DECISION ON A QUESTION NOT  
SPECIFICALLY PROVIDED FOR TO  
WITHDRAW INCORRECT TERMINAL DISCLAIMER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

2875 Michelle Drive, Suite 110  
Irvine, CA 92606  
January 29, 2010

Commissioner:

Petitioner on behalf of Assignee, Agilence, Inc., hereby petitions and requests that the terminal disclaimer dated November 7, 1998 be withdrawn or corrected for the above-identified patent. Assignee owns a 100% interest in this patent. Assignee recently became aware of the incorrect terminal disclaimer filed during the prosecution of the patent.

During prosecution of the application from which the current patent issued, an Office action from the Patent Office was sent on April 13, 1998 (Exhibit A). This is the last Office action from the Patent Office before the issuance of the Notice of Allowability on December 21, 1998 (Exhibit B). In the action, the Examiner provisionally rejected the

application based on non-statutory obvious type double patenting based on a co-pending application 08/963,992. (See page 3 of Exhibit A).

In an Amendment of October 13, 1998 in response to the Office action of April 13, 1998, Applicant's representative at the time refers to a terminal disclaimer (Exhibit C; see page 4). In a supplemental Amendment of November 19, 1998 in response to the same Office action, Applicant again refers to a terminal disclaimer (Exhibit D; see page 5). In conjunction with this supplemental Amendment, the incorrect terminal disclaimer was submitted (Exhibit E).

The incorrect disclaimer identified U.S. Patent 5,216,502, which has an application serial number of 07/629,255 instead of U.S. Patent Application No. 08/963,992 as set forth in the April 13, 1998 Office action. U.S. Patent Application No. 08/963,992 is now abandoned. Throughout the entire file wrapper for the current patent, a non-statutory obvious type double patenting rejection based on U.S. Patent No. 5,216,502 does not appear.

The disclaimer was executed by Barry Katz. In the disclaimer, Barry Katz is identified as an owner and an inventor. The terminal disclaimer however did not correctly state the present extent of the Barry Katz's ownership in the application.

Since U.S. Patent Application No. 08/963,992 is abandoned, a corrected terminal disclaimer to identify and disclaim the term based on US Patent Application No. 08/963,992 instead of U.S. Patent No. 5,216,502 would not limit the patent term of the current patent.

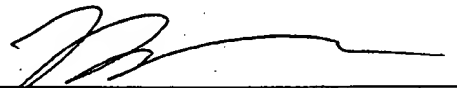
Petitioner therefore hereby petitions and requests the withdrawal the incorrect disclaimer of November 18, 1998. However, if withdrawal of the incorrect disclaimer is not acceptable, Petitioner hereby petitions and requests the correction of the terminal disclaimer to correctly identify and disclaim the term based on US Patent Application No. 08/963,992 (as identified by the May 15, 1996 Office action) instead of U.S. Patent No. 5,216,502.

Appln No. 08/964,305  
Patent No. 5,920,338

The petition fee set forth under 37 C.F.R. §1.17(f) of \$400.00 is being paid via credit card. If additional fees are required, the Commissioner is authorized to charge Deposit Account 50-4407. Please show our docket number with any transaction to the Deposit Account.

Respectfully submitted,

KAUTH, POMEROY, PECK & BAILEY LLP

By   
Patrick Ikehara  
Registration No. 42,681  
949.852.0000

8835

# EXHIBIT A



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/964.305 11/04/97 KATZ

B 97252B.PUS

LN11/0413

EUGENE E RENZ JR  
205 NORTH MONROE STREET  
POST OFFICE BOX 2056  
MEDIA PA 19063-9056

EXAMINER

AJ.A.

ART UNIT

PAPER NUMBER

2713 12

DATE MAILED:

04/13/98

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 10/30/96; ~~11/4/97~~ and 2/9/98

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire -3- month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 17-19 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 17-19 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413.

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

Serial Number: 08/964,305

Page 2

Art Unit: 2713

### DETAILED ACTION

#### *Specification*

1. The application is objected to because of alterations which have not been initialed and/or dated as is required by 37 CFR 1.52© and 1.56. A properly executed oath or declaration which complies with 37 CFR 1.67(a) and identifies the application by serial number and filing date is required.

The specification contains numerous handwritten alterations which would require a new oath or declaration. See pages 6 and 11. Further the handwriting on page 11 are illegible.

#### *Double Patenting*

2. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 17-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-20 of copending Application No. 08/963,992. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to use the equivalent method as set forth in the copending application for the claimed system, and while the claims in the two applications are not duplicates, they are so close in content that they both cover the same thing, despite a slight difference in wording.

This is a **provisional** obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Claim Rejections - 35 USC § 112*

4. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Page 4

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Claim 17, step f) claims "means for selectively positioning the alphanumeric characters of the digital transaction signals on the video image." However, there is no support in the specification for "*selectively positioning* the alphanumeric characters ..on the video image."

5. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

claim 19, "the verifying means" has no antecedent basis.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (P.N. 4,641,203) in view of Clever (P.N. 4,145,715).

Re claim 18, Miller discloses a system for processing related simultaneously recorded video and digital data comprising means (video camera 34) for generating video signals of behavioral events corresponding to a desired transaction (scene or event 66; col. 5, lines 11-12)



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and marking the video signals with a sequence code from a sequence code source (col. 5, lines 43-45); means for storing the sequence coded video signals in a predetermined storage medium (video tape); means (44) for generating digital signals representing data for said transaction, said digital signals include signals representing alphanumeric characters corresponding to the transaction (col. 5, lines 22-24), and marking the digital signal with a matching sequence code signal from an electronic system source (col. 5, lines 41-43); means for storing the sequence coded digital signal in a storage medium different from said predetermined storage medium (diskette); means for retrieving selected stored signals via its sequence code signal (col. 3, lines 3-10); means for retrieving selected stored digital signals via its sequence code signal (col. 3, lines 3-10);

Miller fails to disclose an common electronic system source for producing the sequence code signal. Miller uses the same type of sequence code signal for both the video signal and the data signal. Therefore, it would have been obvious to employ a common electronic system to produce the same sequence code since the same sequence code is being employed by types of signals.

Miller discloses using two displays, but fails to disclose forming a composite video-digital signal by selectively superimposing the signals. Clever teaches a composite signal by superimposing a digital signal on the corresponding retrieved video signals wherein the alphanumeric characters overlies the corresponding behavioral event. Therefore, it would have

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been obvious to one skilled in the art to modify Miller to generate a composite signal as taught by Clever to reduce the need for two monitors.

Re claim 17, claim 17 contains substantially the same limitations as claim 18 except claim 17 claims asynchronously storing separate digital signals representing data from the transaction. Miller discloses that the digital signal may be stored asynchronously at a later time (col. 3, lines 41-46).

Re claims 17 and 19, Miller fails to disclose verifying that the digital transaction signals have not been altered, destroyed, or otherwise tampered with. However, means for checking that the data has not been altered, destroyed, or otherwise tampered such as the encrypted checksum method is well recognized in the art. One skilled in the art would recognize the need to protect the validity of the digital data to ensure that the data is original and unaltered. Therefore, using the encrypted checksum, which is common in the art, on the digital data lacks an inventive step.

Further, there is no inventive step involved in selectively positioning data on the screen (step f in claim 17). It is well recognized in the art that it is undesirable to have overlapping data because it would obscure the picture. Therefore selectively positioning the data signal would be obvious.

#### ***Response to Arguments***

8. Applicant's arguments filed 2-9-98 have been fully considered but they are not persuasive.

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Applicant argues in the remarks that applicant's invention broadly relates to surveillance systems that record buffered point-of-sale (POS) transaction events for review at a later time by employing video cameras to monitor and record transactions and employing cash register, bar code reader or other registering device to collect digital data relating to the transaction. This is not persuasive because the claims do not reflect this. The claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner suggests amending the claims to reflect the actual invention as disclosed in the specification to narrow the scope of the claims.

Applicant's arguments with regard to the Miller reference has been noted. However, the claims still read on the disclosure of Miller. Miller discloses applicant's inventive concept which is to tag two different types of signals with a common identifying code and later use the common identifying code to match the signals together. All the other differences between the two inventions are either obvious variations or functionally equivalent elements. While Miller uses different elements such as a cassette tape and manual entries through a keyboard, the claims do not preclude the use of these elements. As to the feature of having two displays rather than superimposing the video and data signals, there is no inventive step to overlaying data onto one display. It is well recognized in the art overlaying different signals onto one display would provide improved viewing so the user would not have to switch between monitors.

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Applicant's arguments with regard to Clever has been noted. However, Clever was used to show how common it is to combine different signals for display on a single screen. As to applicant's argument that Clever uses black out portions, the claims do not preclude having a black out portion. As to applicant's arguments that Clever does not selectively place transaction data on the video image, claim 18 does not call for this limitation, and in any event, it is well recognized in the art that it is obvious to selectively place display data in any advantageous location.

*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia Au whose telephone number is (703) 308-6604. The examiner can normally be reached on Monday - Thursday from 6:30 am - 4:00 pm EST. The examiner can also be reached on alternate Fridays.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

The fax phone number for Formal or Official faxes is (703) 308-9051 or (703) 308-9052.  
The fax number for informal or draft faxes is (703) 308-5399.

  
AMELIA AU  
PRIMARY EXAMINER  
GROUP 2710

aaau  
April 12, 1998

## EXHIBIT B



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/964,305	11/04/97	KATZ	B 97252B.PUS

EUGENE E RENZ JR  
205 NORTH MONROE STREET  
POST OFFICE BOX 2056  
MEDIA PA 19063-9056

LN11/1221

EXAMINER  
LEE, Y

ART UNIT	PAPER NUMBER
2713	18

DATE MAILED: 12/21/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Notice of Allowability**Application No.  
08/984,305

Applicant(s)

Barry Katz

Examiner  
Y. LeeGroup Art Unit  
2713

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance and Issue Fee Due or other appropriate communication will be mailed in due course.

☒ This communication is responsive to the amendment filed 11/20/98

☒ The allowed claim(s) is/are 24-28 (renumbered as 1-5, respectively)

☐ The drawings filed on \_\_\_\_\_ are acceptable.

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE THREE MONTHS FROM THE "DATE MAILED" of this Office action. Failure to timely comply will result in ABANDONMENT of this application. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION, PTO-152, which discloses that the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.

☒ Applicant MUST submit NEW FORMAL DRAWINGS

☒ because the originally filed drawings were declared by applicant to be informal.

☐ including changes required by the Notice of Draftsperson's Patent Drawing Review, PTO-948, attached hereto or to Paper No. \_\_\_\_\_

☐ including changes required by the proposed drawing correction filed on \_\_\_\_\_, which has been approved by the examiner.

☐ including changes required by the attached Examiner's Amendment/Comment.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the reverse side of the drawings. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

☐ Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Any response to this letter should include, in the upper right hand corner, the APPLICATION NUMBER (SERIES CODE/SERIAL NUMBER). If applicant has received a Notice of Allowance and Issue Fee Due, the ISSUE BATCH NUMBER and DATE of the NOTICE OF ALLOWANCE should also be included.

**Attachment(s)**

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ Notice of Informal Patent Application, PTO-152

☐ Interview Summary, PTO-413

☐ Examiner's Amendment/Comment

☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material

☐ Examiner's Statement of Reasons for Allowance

  
TOMMY F. CHIN  
SUPERVISORY PATENT EXAMINER  
GROUP 2700

<b>Notice of References Cited</b>			Application No. <b>08/964,365</b>		Applicant(s) <b>Barry Katz</b>	
			Examiner <b>Y. Lee</b>		Group Art Unit <b>2713</b>	
Page 1 of 1						

U.S. PATENT DOCUMENTS						
*	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS	
x	A	3,935,380	1/27/76	Coutta	348	150
x	B	4,328,218	4/20/82	Coutta et al	348	150
	C					
	D					
	E					
	F					
	G					
	H					
	I					
	J					
	K					
	L					
	M					

FOREIGN PATENT DOCUMENTS						
*	DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS		
*	DOCUMENT (including Author, Title, Source, and Pertinent Pages)	DATE
	U	
	V	
	W	
	X	

\* A copy of this reference is not being furnished with this Office action.  
(See Manual of Patent Examining Procedure, Section 707.05(a).)



## EXHIBIT C

I hereby certify that this correspondence being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, DC 20231, on the date indicated below:

October 13, 1998  
Date



SIGNATURE

#5/E  
Rose  
10-29-98

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the application of  
B. KATZ et al.

: Docket No.: 97252B.PUS

:

: Group Art Unit: 2713

:

Serial No.: 08/964,305

: Examiner: Tommy P. Chin

:

Filed: November 4, 1997

For: **ASYNCHRONOUS VIDEO EVENT AND TRANSACTION DATA  
MULTIPLEXING TECHNIQUE FOR SURVEILLANCE SYSTEMS**

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

**AMENDMENT**

In response to the Office Action dated April 13, 1998, please amend the above-entitled application as follows:

**IN THE SPECIFICATION:**

Insert new pages 6 and 11 attached hereto thereby deleting the handwritten notations.

**IN THE CLAIMS:**

Cancel claims 17-19, inclusive, without prejudice.

Add the following new claims.

11/2/98

20. A system for providing verifiable surveillance data by selectively positioning digital data on a video image without obscuring the video image, comprising the steps of:
- a) a means for generating video signals of behavioral events corresponding to a desired transaction and marking the video signals with a sequence code from a sequence code source;
  - b) a means storing the sequence coded video signals in a predetermined recording medium;
  - c) a means for generating digital signals representing data for said transaction, said digital signals including signals representing alphanumeric characters corresponding to the transaction, and marking the digital signal with a matching sequence code signal from an electronic system source common to the source in step a);
  - d) a means for storing the sequence coded digital signal in a recording medium different from said predetermined storage medium;
  - e) a means for retrieving selected stored video signals via its sequence code signal;
  - f) a means for retrieving selected stored digital signals via its sequence code signal;
  - g) a means for forming a composite video-digital signal by selectively superimposing retrieved digital signals on the corresponding retrieved video signals of step e) wherein the digital signals overlaid the corresponding behavioral event so as not to obscure the video signal;
  - h) a means for verifying that the video and digital signals have not been altered or otherwise tampered with; and
  - i) a means for displaying the composite video signal on a monitor.

E  
cont

21. The system in accordance with Claim 20 wherein the sequence code signals are independently generated signals synchronized from a common source.

22. The system in accordance with Claim 20 wherein a timing signal is generated with said video signal of step a) and with said digital signal of step b), a message checksum is encoded with the video signal, and verification of the checksum is utilized to synchronize said two timing signals.

22. A system in accordance with Claim 20 wherein the sequence code of steps a) and b) is a transaction sequence number.

23. A system in accordance with Claim 20 wherein a check sum code is encrypted on the video and digital signals to provide a tamper-proof verification of the composite video-digital signals.

EE  
cancel

#### REMARKS

Claims 17-19, inclusive, have been canceled without prejudice. Claims 20-22 have added. Pages 6 and 11 of the specification are enclosed herewith to overcome the handwritten insertions. A newly executed Declaration/Power of Attorney and Terminal Disclaimer in compliance with 37 CFR 1.321(b) and (c), which Applicant believes overcomes non-statutory double patenting objections, will be filed in this case promptly once received by the Applicant.

Barry Katz, Robert DiGirolamo and Applicant's undersigned attorney, wish to thank the Examiner for the courtesy and assistance extended during an interview regarding this application on September 16, 1998. The above amendment and how the claims now set forth Applicant's invention in terms which distinguish it patentably over the art of record were discussed in detail at the interview. Favorable reconsideration is respectfully requested in view of the above amendments and following comments which summarize the discussions with the Examiner.

Applicant's detailed comments concerning the Miller, Clever and Odle patents are presented in the Preliminary Amendment filed in the case and adequately set forth the patentable distinctions of Applicant's invention over the art in addition to the following statements.

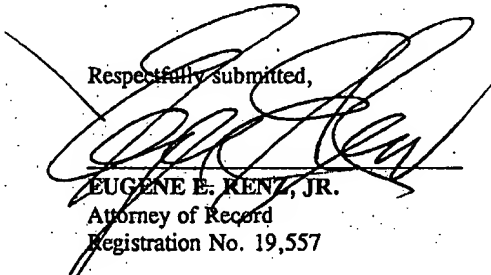
In summary, none of the patents cited by the Examiner address the important aspect of Applicant's invention namely a truly verifiable surveillance system which is truly tamper-proof and, wherein the composite video and digital signals are coded and encrypted in a controlled manner so

that they may be stored separately and the digital data superimposed on the recorded related video at a later time without obscuring the image.

It is believed that the claims now presented define patentably over the art of record and accordingly favorable consideration of these claims and passage of the case to issue is respectfully solicited. If, however, there are additional matters which require attention, Applicant's attorney respectfully request the Examiner to contact him via telephone in thereby expedite prosecution of this case.

Telephone:  
(610) 565-6090  
Facsimile:  
(610) 566-9790  
P.O. Box 2056  
205 North Monroe Street  
Media, PA 19063-9056

Respectfully submitted,



EUGENE E. RENZ, JR.  
Attorney of Record  
Registration No. 19,557

## EXHIBIT D

11/19/98 14:31 EUGENE RENZ → 17033089051

T1 2713

NO. 562 081

Official

FAX RECEIVED

NOV 20 1998

I hereby certify that this correspondence is being fax addressed to Examiner Y. Lee of the U.S. Patents and Trademark Office, Washington, DC 20231 at 703-308-9051 on the date indicated below.

November 19, 1998  
Date

SIGNATURE

Group 2700

#16 F

Rose

12-3-98

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of  
B. KATZ et al.

: Docket No.: 97252B.FUS

:

: Group Art Unit: 2713

:

: Examiner: Y. Lee

:

Serial No.: 08/964,305

Filed: November 4, 1997

For: ASYNCHRONOUS VIDEO EVENT AND TRANSACTION DATA  
MULTIPLEXING TECHNIQUE FOR SURVEILLANCE SYSTEMS

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

**AMENDMENT**

Supplementing the Amendment filed October 16, 1998, please amend the above-entitled application as follows:

**IN THE CLAIMS:**

Cancel claims 20-23, inclusive, without prejudice.

Add the following new claims.

WML

F



24. A system for providing verifiable surveillance data by selectively positioning digital data on a video image without obscuring the video image, comprising:

- a) means for generating video signals of behavioral events corresponding to a desired transaction and marking the video signals with a sequence code from a sequence code source;
- b) means for storing the sequence coded video signals in a predetermined recording medium;
- c) means for generating digital signals representing data for said transaction, said digital signals including signals representing alphanumeric characters corresponding to the transaction, and marking the digital signal with a matching sequence code signal from an electronic system source common to the source in step a);
- d) means for storing the sequence coded digital signal in a recording medium different from said predetermined recording medium;
- e) means for retrieving selected stored video signals via its sequence code signal;
- f) means for retrieving selected stored digital signals via its sequence code signal;
- g) means for forming a composite video-digital signal by selectively superimposing retrieved digital signals on the corresponding retrieved video signals of step e) wherein the digital signals overlie the corresponding behavioral event so as not to obscure the video signal;
- h) means for verifying that the video and digital signals have not been altered or otherwise tampered with; and
- i) means for displaying the composite video signal on a monitor.

11/19/98

14:31

EUGENE RENZ → 17033009051

NO.562

003

2 ~~25~~ A system in accordance with Claim ~~24~~<sup>1</sup> wherein the sequence code signals are independently generated signals synchronized from a common source.

3 ~~26~~ A system in accordance with Claim ~~24~~<sup>1</sup> wherein said sequence code is encrypted and imposed on the video and digital signals to provide a tamper-proof verification of the composite video-digital signals.

71  
cont  
4 ~~27~~ A system as claimed in claim ~~26~~<sup>3</sup> wherein the tamper proof verification means comprises a checksum.

5 28. A system for processing related asynchronously recorded video and digital data to produce a composite video wherein the related video and digital data are combined in a manner to provide verifiable surveillance, comprising:

a) means for generating video signals of behavioral events corresponding to a desired transaction and marking the video signals with a sequence code from a sequence code source;

b) means storing the sequence coded video signals in a predetermined recording medium;

c) means for generating digital signals representing data for said transaction, said digital signals including signals representing alphanumeric characters corresponding to the transaction, and marking the digital signal with a matching sequence code signal from an electronic system source common to the source in step a);

d) means for storing the sequence coded digital signal in a recording medium different from said predetermined storage medium;

e) means for retrieving selected stored video signals via its sequence code signal;

f) means for retrieving selected stored digital signals via its sequence code signal;

g) means for forming a composite video-digital signal by selectively superimposing retrieved digital signals on the corresponding retrieved video signals of step c) wherein the digital signals overlie the corresponding behavioral event so as not to obscure the video signal;

h) means for verifying that the video and digital signals have not been altered or otherwise tampered with; and

i) means for displaying the composite video signal on a monitor.

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**REMARKS**

Claims 20-23, inclusive, have been canceled without prejudice. Claims 24-28, inclusive, have added. A Terminal Disclaimer in compliance with 37 CFR 1.321(b) and (c), which Applicant believes overcomes non-statutory double patenting objections, is enclosed herewith.

Barry Katz, Robert DiGirolamo and Applicant's undersigned attorney, wish to thank the Examiner for the courtesy and assistance extended during a recent telephone interview regarding this application on November 17, 1998. The above supplemental amendment and how the claims now set forth Applicant's invention in terms which distinguish it patentably over the art of record were discussed in detail at the interview. Favorable reconsideration is respectfully requested in view of the above amendments and following comments which summarize the discussions with the Examiner.

Applicant's detailed comments concerning the Miller, Clever and Odle patents are presented in the Preliminary Amendment filed in the case and adequately set forth the patentable distinctions of Applicant's invention over the art in addition to the following statements.

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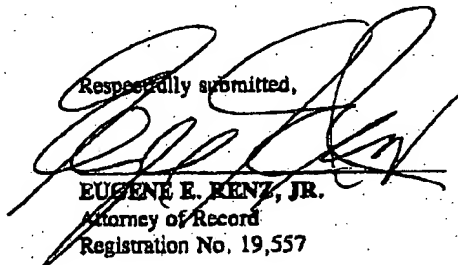
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In summary, none of the patents cited by the Examiner address the important aspect of Applicant's invention namely a truly verifiable surveillance system which is truly tamper-proof and, wherein the composite video and digital signals are coded and encrypted in a controlled manner so that they may be stored separately and the digital data superimposed on the recorded related video at a later time without obscuring the image.

It is believed that the claims now presented define patentably over the art of record and accordingly favorable consideration of these claims and passage of the case to issue is respectfully solicited. If, however, there are additional matters which require attention, Applicant's attorney respectfully request the Examiner to contact him via telephone in thereby expedite prosecution of this case.

Respectfully submitted,



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the application of  
B. KATZ et al.

: Docket No.: 97252B.FUS

: Group Art Unit: 2713

Serial No.: 08/964,305

: Examiner: Tommy F. Chio

Filed: November 4, 1997

For: **ASYNCHRONOUS VIDEO EVENT AND TRANSACTION  
DATA MULTIPLEXING TECHNIQUE FOR SURVEILLANCE SYSTEMS**

To the Assistant Commissioner of Patents:

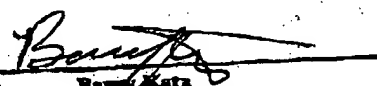
Sir:

**TERMINAL DISCLAIMER**

I, **BARRY KATZ**, residing at 503 Cindy Circle Penlynn, PA 19422, represents that I am the inventor and owner of the above-identified case. I hereby disclaim, except as provided below, the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of Patent No. 5,216,502, as presently shortened by any terminal disclaimer. I hereby agree that any patent so granted on the instant application shall be enforceable only for and during such period that it and the above listed patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors,

RECEIVED: 11/19/98 13:55 08/964305  
0 609 866 0004

Date: **NOVEMBER 18, 1998**

By:   
Name: **Barry Katz**  
Its: **Inventor/Owner**